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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/631,583
Filing Date: August 03, 2000
Appellant(s): LIWERANT ET AL.

Liwerant et al
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 30, 2009 appealing from the Office action mailed April 10, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0047294	ROTHSCHILD	11-2001
6,236,395	SEZAN ET AL	5-2001

XP-002150023 "Streaming Email", 04 September 1998, pp. 303-317

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 1 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of "Streaming Email" (XP-002150023, supplied by applicant) and Sezan et al. (6,236,395, of record) [Sezan].

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

- (a) acquiring a video segment from a sender at a computer system (the video portion of a video message which is the personal communication, paragraph 48);

- (b) acquiring advertisements from advertisers at the computer system (third party, advertiser provided advertisements, paragraph 49);

- (c) offering to the sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

- (d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose acquiring a still image in the form of a thumbnail and directly in response to the indication accepted in step (d), automatically at the computer system:

- (i) assuring that the video segment is in a streaming format;
- (ii) creating an identifier for the video segment, wherein the identifier includes the still image and a link to the video;
- (iii) associating the video segment and the advertisement; and
- (iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements from advertisers (paragraph 64); and
receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose receiving a still image in the form of a thumbnail confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link and the still image to the network accessible location, generating an electronic

communication containing the identification tag and addressed to the electronic email address, and transmitting the electronic communication.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to

include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

(10) Response to Argument

(i) *lack of anticipation of all claimed limitations*

First, appellant argues that the “assuring” and “confirming” steps claimed indicate that a determination is made by analyzing a file to determine if in fact it is in a streaming video format. The examiner addressed this argument in the Final Rejection mailed on April 10, 2009 by stating that the active analyzing of a file to determine if it is in fact in a streaming video format is not necessarily required by the claim language, said steps only require that the system and method take a step that mandates the file is in streaming format prior to sending. In response to the examiner’s argument that such limitations cannot be read into the claims, appellant here argues that there is no teaching in the prior art of record that said assuring and confirming steps take place at the computer system of claim 1 and the video server of claim 36, respectively.

In response, the “Streaming Email” document contains the following disclosure on page 312:

“Some options to consider before sending a message include attaching the player to the message in case the recipient doesn’t have it. Just check off the corresponding box at the bottom of the window. Next to that is the Allow Download checkbox. Enabling that option means that the recipient can also download the actual message as well as stream it. That is a good option for

when the recipient would like to have a better quality, perhaps uncompressed, video file."

Given this disclosure, the only way for the video server through which the message is being sent can provide a recipient with the option to download an uncompressed version of the uploaded file (as indicated by the sender checking the 'Allow Download' checkbox) is for the sender to upload the uncompressed video file and have the server itself perform the designated compression ("Streaming Email", page 311, steps 6 and 7). This way, if a user chooses to download the entire file, it is downloaded in an uncompressed format, but if the user chooses to stream the file, it is compressed according to the designated compression settings prior to being transmitted. Therefore, according to the disclosure of the "Streaming Email" document, it is the Video Express Email server, not the client sending the message, which "assures" and "confirms" that uploaded files are in a compressed format, given that it is the server which performs the compression.

(ii) *failure to take into consideration teaching away arguments*

Here, appellant reasserts the argument that because the "Streaming Email" document includes using a proprietary player to play the streaming video files, this teaches away from both the claimed invention and the Rothschild disclosure, neither of which expressly require a proprietary player.

In response, appellant still has not made the argument as to how this constitutes "teaching away" from the claimed invention, since the claims make no requirement

regarding whether a proprietary player is needed one way or the other. It is impossible to say that "Streaming Email" teaches away from either the claimed invention or the Rothschild disclosure when either invention could be implemented as one using a proprietary player with no change at all to the existing disclosed requirements.

Further, appellant argues that the only way to deliver the proprietary player is by attaching it to an email message, which teaches away from the concept of minimizing message size.

In response, the option of attaching the player is just that, an option. Further, there is no requirement that a receiver must receive the player via a message from another user, since a client could just as easily download or install the player from another source. Also, as stated previously by the examiner, the "Streaming Email" document emphasizes that to speed up the delivery of messages, one should **not** include the player or any downloadable multimedia files ("Streaming Email, page 312).

Lastly, appellant argues that the teaching found in Sezan regarding using thumbnail images to discern between several possible video selections teaches away by pointing to the bandwidth limitations to consider at the time of invention, making the argument that it would be unrealistic to include several video attachments to an email to justify the context differentiation purpose that Sezan uses thumbnail images for.

In response, appellant's arguments seem to have lost sight of both the claimed invention and the proposed prior art combination. The entire purpose of using pointers within an email rather than sending video itself as an attachment is to minimize

message size. This was explained in the combination of Rothschild in view of "Streaming Email". Consequently, the messages being sent by the proposed combination have no attachments at all. This renders appellant's argument regarding the impact of including attachments to email messages irrelevant to the proposed combination. An email could include any number of pointers and still be of minimum size since the pointers constitute far less data than an actual video file.

Also, as previously stated by the examiner, the actual use that Sezan includes in his disclosure for thumbnail images is an additional use for thumbnail images beyond their utility as indicators for what is found within a video file, which is the stated motivation. Appellant argues that this constitutes "...utilizing Appellant's cited benefit for supplanting his previous motivation for combination of the teaching of the references." and is hindsight reconstruction.

However, the cited benefit of using thumbnail images, as taught by Sezan, is that they provide an indicator as to the content of a video and assists the viewer whether to view the associated file was first proposed in the Non-Final Rejection mailed on July 15, 2008. The proposed motivation has not changed since it was first introduced in July of 2008, and further, the thumbnails disclosed by Sezan are used to distinguish between videos by first giving an indicator as to what the content of the video itself actually represents. There has been no "supplanting" of motivations, nor has appellant's specification been used as a roadmap to reconstruct the invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Dominic D Saltarelli/
Primary Examiner, Art Unit 2421

Conferees:

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424